

**REMARKS**

In the Office Action the Examiner noted that claims 1-53 are pending in the application, and the Examiner rejected all claims. The Examiner's rejections are traversed below, and reconsideration of all rejected claims is respectfully requested.

**Claim Rejections Under 35 USC §112**

In item 2 on page 2 of the Office Action the Examiner rejected claims 13 and 41 under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. The Examiner stated that the claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The Examiner went on to state that it is unclear how the separate member with the grooves is coupled to the movable body. The Applicant respectfully traverses the Examiner's rejections of these claims.

Claims 13 and 41 each recite a movable body "wherein the grooves are formed on a separate member coupled to a longitudinal side surface of the movable body." This embodiment of the present invention is stated in Paragraph [0027] of the present application, and is clearly illustrated in Figure 4 of the present application. MPEP §2164.01 states that the test of enablement is whether the claimed invention is enabled so that any person skilled in the art can make and use the invention without undue experimentation. The Applicant respectfully submits that the coupling of two elements such as described in claims 13 in 41 would not only be attainable without undue experimentation, but would be clear to anyone skilled in the art. In construction terms, there are several possibilities for coupling two elements while assembling a device, and there would be no need to limit the subject claims to one such construction for so simple a concept as coupling two components.

In order to make a rejection, the Examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. In re Wright, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993). In light of the fact that there are myriad possibilities that are well known in the art to couple two elements as described in claims 13 and 41, the Applicant respectfully submits that the Examiner has not met the burden of a reasonable basis to question the enablement. Therefore, the Applicant further respectfully requests the withdrawal of the Examiner's §112 rejections of these claims.

Claim Rejections Under 35 USC §103

In items 4-15 on pages 3-7 of the Office Action the Examiner rejected claims 1-2, 6, 7-17, 28-29, and 34-44 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 5,220,747, issued to Cherry et al. (hereinafter referred to as "Cherry") in view of U.S. Patent 6,711,778, issued to Sparkman (hereinafter referred to as "Sparkman"). The Applicant respectfully traverses the Examiner's rejections of these claims.

In item 11 on page 5 of the Office Action the Examiner acknowledged several elements of the claimed invention that are not disclosed by Cherry, including, as claimed in claim 1 of the present application, a control unit controlling an opposite direction movement of the movable body in a multi-stage manner such that the refrigerator door is maintained at a selected one of a plurality of predetermined positions between a closed position and a fully open position. The Examiner went on to state that Sparkman discloses these features, and further that "it would have been obvious for a person of ordinary skill in the art to modify the device of Cherry by adding one more groove to the moveable body and by adding the locking unit and control chamber of Sparkman to provide a plurality of stop positions." However, the Applicant respectfully submits that there is no basis for this statement by the Examiner.

As stated in the previously filed Amendment, there is no motivation to combine Cherry and Sparkman. MPEP § 2142 states that "[w]hen the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the Examiner to explain why the combination of the teachings is proper." Here, the Examiner has simply stated, with no evidence to support the assertion, that "[a]t the time of the invention it would have been obvious for a person of ordinary skill in the art to modify the device of Cherry by adding one more groove to the moveable body and by adding the locking unit and control chamber of Sparkman to provide a plurality of stop positions." The Examiner has provided no explanation at all as to why one would be motivated to add one more groove to the movable body of Cherry, nor any reason for adding the locking unit and control chamber of Sparkman. As a matter of fact, as Cherry already has a locking mechanism which holds the refrigerator door in place at a ninety degree angle and one greater angle, the Applicant fails to understand why anyone skilled in the art would be moved to add the locking unit and control chamber of Sparkman. The Examiner is required to present actual evidence and make particular findings related to the motivation to combine the teachings of the references. In re Kotzab, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); In re Dembiczak, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Broad conclusory statements regarding the teaching of multiple references, standing alone, are not "evidence." Dembiczak, 50 USPQ2d

at 1617. "The factual inquiry whether to combine the references must be thorough and searching." In re Lee, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002) (citing McGinley v. Franklin Sports, Inc., 60 USPQ2d 1001, 1008 (Fed. Cir. 2001)). The factual inquiry must be based on objective evidence of record, and cannot be based on subjective belief and unknown authority. Id. at 1433-34. The Examiner must explain the reasons that one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious. In re Rouffet, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998).

Also, the Applicant respectfully submits that not only is there no motivation to combine the two references of Cherry and Sparkman, the two references actually teach away from one another. "Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art" (MPEP 2143.01). "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). The disclosure of Cherry provides an arm that is biased toward a closed position until the door is opened to a predetermined angle, and biased toward an open position when the door is opened to an angle greater than the predetermined angle. Therefore, to combine the disclosure of Sparkman, and therefore provide a plurality of stop positions, would counteract the very essence of the Cherry disclosure, which is biasing the door toward either an open or closed position depending upon the angle of the open door. Therefore, the Applicant respectfully submits that the disclosure of Cherry teaches away from the combination with Sparkman.

#### Examiner's Response to Arguments

In items 19-20 on pages 10-11 of the Office Action the Examiner provided a response to the arguments made by the Applicant in the Amendment filed on November 28, 2005. The Applicant respectfully traverses the Examiner's response with the following points.

In regard to the Applicant's assertion that Cherry and Sparkman teach away from one another, the Examiner provided the following statements:

In the applicant's remarks on page 16, the applicant states that "...the very essence of the Cherry disclosure, which is biasing the door toward either an open or closed position depending on the angle of the door." The applicant is incorrect in making this statement; the door of Cherry also has a stable angle of the door at

approximately 90 degrees (Col. 4, lines 12-15). It is in having this stable angle that is the one of the essences of the Cherry disclosure, along with the having a biased closure and biased open means to allow for use of the refrigerator when the user's hands are full (Col. 1, lines 9-30). Therefore Cherry is teaching a plurality of stop positions (closed, 90 degrees, and fully open) and does not teach away from the Sparkman reference, which teaches the same function of a plurality of stop, by using a plurality of grooves.

The Applicant respectfully submits that the Examiner has mischaracterized the arguments made by the Applicant, as well as the clearly stated goal of the Cherry reference. It is clear from the entirety of Cherry that the essence of the invention is a device to bias the refrigerator door toward either an open or closed position (the open position described by the Examiner is one of the open positions already discussed by the Applicant). The title of the invention is REFRIGERATOR DOOR BIASING MECHANISM. The abstract of Cherry explains that the biasing mechanism biases the door toward the closed position when the door is less than about 30 degrees open, and toward the open position when the door is more than about 30 degrees open. It is true that two stable open positions are provided in Cherry (including the fully open position), but this does not change the fact that the door is biased one way or the other when not locked into those positions. Further, the Examiner has stated that the Applicant is "incorrect" because the door of Cherry has the stable open position at 90 degrees. The Applicant respectfully submits that this has no bearing on the previous assertions by the Applicant, because the door is nevertheless biased toward the open position discussed by the Examiner, and therefore does not logically conflict with the statements made by the Applicant. Cherry quite obviously has the two stable open positions at 90 degrees and fully open. However, while the Examiner is correct in stating that the stable open position at 90 degrees is integral to the invention of Cherry, this also supports the Applicant's position that the biasing toward that position or toward the closed position would be countered by the addition of further stop positions.

As Cherry provides a spring biasing system to bias the refrigerator door toward either an open or closed position, the addition of more notches to the member to match the Sparkman disclosure would prevent the biasing toward the 90 degree open position, which the Examiner has identified as one of the "essences" of Cherry. The long straight edge 66 of the member 38 works in conjunction with the spring 56 to provide this bias toward the 90 degree position, and further stop positions would render the inventive aspect of Cherry unsatisfactory. If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984) cited by MPEP §2143.01. As the

addition of the stop positions of Sparkman would obviously negate the intended purpose of Cherry, which the Applicant submits would be recognized by anyone skilled in the art, the modification proposed by the Examiner is not valid. Also, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie obvious*. In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959) cited by MPEP §2143.01. Sparkman, similar to the present application, does not incorporate a biasing device to bias the door in an open or closed direction. As a plurality of stop positions between the close position and the fully opened position would therefore change the principle of the biasing device of Cherry, there is no *prima facie obviousness*.

Also, the Examiner stated that the motivation to combine Cherry and Sparkman is to provide a plurality of stops to have more than one “fully open” position, citing lines 20-22 of column 1 of Cherry. However, the cited section merely discusses one stable open position between the closed position and the fully opened position. Directly after those cited lines, Cherry goes on to say that it is desirable for the door to be easily movable between those positions since gravity no longer plays the supporting role in closing the doors that it once did (Column 1, Lines 27-44), which brought about the motivation for the biasing device. Column 3, Line 37 through Column 4, Line 40 clearly shows that there would be no motivation to bias the refrigerator door in an open direction if a user would have to exert the force to move it further along a plurality of stopped positions along the way to the fully open position. This is why there is only one open position provided between the closed and fully open positions of Cherry, rather than the plurality of predetermined positions between a closed position and fully open position as claimed in claim 1 of the present application. In maintaining a *prima facie obviousness* rejection, the Examiner is required to evaluate the record as a whole, and to account for contrary teachings existing in the record. In re Young, 18 USPQ2d 1089 (Fed. Cir. 1991) cited by MPEP §2143.01. Further, as previously stated, such combinations cannot render the combined product to be unsatisfactory for its intended purpose, as stated in MPEP §2143.01. As Sparkman is not biased, and therefore is free to work with a variety of stop positions between the closed and fully open positions, it clearly teaches away from Cherry.

The Present Invention Distinguishes Over the Cited References

As stated in the previous section of this Response, there is no motivation to combine Cherry and Sparkman. Further, as the proposed modification would render each of the cited

references unsatisfactory for their respective intended purposes, there is actually motivation to not combine the two references. Therefore, claim 1 of the present application patentably distinguishes over the cited references, and the Applicant respectfully requests the withdrawal of the Examiner's §103 rejection.

Claims 2, 6, and 7-17 depend from claim 1 and include all of the features of that claim plus additional features which are not taught or suggested by the cited references. Therefore, it is respectfully submitted that claims 2, 6, and 7-17 also patentably distinguish over the cited references.

Claim 28 of the present application recites "a control unit to control an opposite directional movement of the movable body in a multi-stage manner such that the refrigerator door is maintained at a selected one of a plurality of predetermined positions between a closed position and a fully open position." As stated above in regard to claim 1, there is no motivation to combine the references of Cherry and Sparkman. Therefore, the Applicant respectfully submits that claim 28 also patentably distinguishes over the cited references.

Claims 29 and 34-44 depend from claim 28 and include all of the features of that claim plus additional features which are not taught or suggested by the cited references. Therefore, it is respectfully submitted that claims 29, 34-35, and 40 also patentably distinguish over the cited references.

In item 16 on pages 7-8 of the Office Action the Examiner rejected claims 3-5 and 30-33 under 35 U.S.C. §103(a) as being unpatentable over Cherry in view of Sparkman as applied to claim 1 and 28, and further in view of U.S. Patent No. 5,896,619, issued to Koopman (hereinafter referred to as "Koopman"). The Applicant respectfully traverses the Examiner's rejections of these claims.

As previously discussed in this response, claims 1 and 28 patentably distinguish over Cherry and Sparkman. Furthermore, claims 3-5 and 30-33 depend from claims 1 and 28, respectively, and include all of the features of those respective independent claims plus additional features which are not taught or suggested by Cherry and Sparkman. Koopman discloses a link bar hinged at a first end thereof to an end of a movable body, and connected at a second end thereof to a refrigerator door. Thus, the disclosure of Koopman does not cure the deficiencies of Cherry and Sparkman in regards to the present claims. Therefore, it is respectfully submitted that claims 3-5 and 30-33 also patentably distinguish over the cited references.

In items 17-18 on pages 8-10 of the Office Action the Examiner rejected claims 18-27

and 45-53 under 35 U.S.C. §103(a) as being unpatentable over Cherry in view of Sparkman as applied to claims 1 and 28, and further in view of U.S. Patent No. 5,706,551, issued to Jeynes et al. (hereinafter referred to as "Jeynes"). The Applicant respectfully traverses the Examiner's rejections of these claims.

Claims 18 and 45 each recite "a control unit to control an opposite directional movement of the movable body in a multi-stage manner such that the refrigerator door is maintained at a selected one of a plurality of predetermined positions between a closed position and a fully open position." As stated above in regard to claim 1, there is no motivation to combine the references of Cherry and Sparkman. Jeynes apparently discloses a dampening unit to close a door, and therefore does not cure the deficiencies of Cherry and Sparkman regarding the claims of the present invention. Therefore, the Applicant respectfully submits that claims 18 and 45 also patentably distinguish over the cited references.

Claims 19-27 and 46-53 depend from claims 18 and 45, respectively, and include all of the features of those respective claims plus additional features which are not taught or suggested by the cited references. Therefore, it is respectfully submitted that claims 19-27 and 46-53 also patentably distinguish over the cited references.

### Summary

There being no further outstanding objections or rejections, it is respectfully submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Serial No. 10/646,863

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: 03/22/06

By: Thomas L. Jones  
Thomas L. Jones  
Registration No. 53,908

1201 New York Avenue, NW, Suite 700  
Washington, D.C. 20005  
Telephone: (202) 434-1500  
Facsimile: (202) 434-1501